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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/786,937	01/22/97	BOUCHARD	P 235299/96001

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EXAMINER

DELACROIX MUIRHEI, C

ART UNIT

PAPER NUMBER

1614

16

DATE MAILED: 02/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/786,937

Applicant(s)

BOUCHARD et al

Examiner

Delacruz-Muirhead

Group Art Unit

1614

☒ Responsive to communication(s) filed on 11/18/99☒ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 15, 16, 18-24, 26-33 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 15, 16, 18-24, 26-33 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Claims 21, 22 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Diedrich et al.
2. Claims 15, 16, 18-24, 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diedrich et al. in view of Felberbaum et al.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The following is responsive to Applicant's amendment received Nov. 18, 1999.

No claims are cancelled. Claims 15, 16, 18-24 and 26-33 are currently pending.

The previous rejection of claim 18 under 35 USC 112, paragraph 2, set forth in the office action mailed March 3, 1999 and maintained in the office action mailed Aug. 18, 1999, is **withdrawn** in view of Applicant's amendment and the remarks contained therein.

Applicant's arguments traversing the previous grounds of rejection under 35 USC 102(b); and 35 USC 103(a), set forth in paragraphs 1-6 of the office action mailed March 3, 1999 and maintained in the office action mailed Aug. 18, 1999 have been considered but are not found to be persuasive.

Said rejections are maintained essentially for the reasons given previously in the office action mailed March 3, 1999 and Aug. 18, 1999, with the following additional comment:

Concerning the previous rejection of claims 21, 22 and 33 under 35 USC 102(b), Applicant again argues that the Diedrich reference fails to teach each and every element of the claimed invention as is required by 35 USC 102. Yet, Applicant's single argument is not convincing. Diedrich discloses the invention substantially as claimed. See the office action mailed March 3, 1999.

With respect to the previous rejection of claims 15, 16, 18-24, 26-33 under 35 USC 103(a), Applicant maintains that the Felberbaum reference is not prior art in view of the declaration received Nov. 23, 1998. Applicant, at pages 3-4 of the amendment, appears to clarify what the declaration of Nov. 23, 1998 is attempting to establish. It appears, from Applicant's remarks, that K. Diedrich alone is the author of the article and is the inventor of the present claims (unidentified by Applicant), while, on the other hand, the subject matter of the present claims (also unidentified by Applicant) are the result of work on the part of the remaining co-inventors, which are not listed in the Felberbaum article.

Said remarks have been considered but are not found to be persuasive.

As stated in the previous office actions, the declaration filed on Nov. 23, 1998 has been deemed ineffective to overcome the Felberbaum et al. reference. The declaration is deficient in that it is not clear how said declaration serves to establish "same inventive entity" between the inventors in the instant application and the remaining author Diedrich K. in the prior art. Applicant's remarks at pages 3-4 of the amendment do not further simplify the issues at hand and regretfully do not clarify the statements set forth in the Declaration. As argued previously, paragraphs 3 and 4 of the declaration appear to contradict each other. In paragraph 3, Applicant

states that they, i.e. all of the named inventors, are the original inventors of the disclosure in the Felberbaum reference, yet at paragraph 4, it is stated that the co-inventors Bouchard, Frydman, Devroey and Engel are not listed as co-authors on the Felberbaum reference because "they were not directly involved in carrying out this particular study". It is not clear to the Examiner to what "this particular study refers". If it refers to the study in the article, then the named co-inventors are actually not the inventors of the subject matter disclosed in the reference and the reference remains a publication by another.

Double Patenting

The previous provisional obviousness-type double patenting rejection set forth in paragraphs 4-5 of the office action mailed Aug. 18, 1999 is maintained until receipt and approval of a Terminal Disclaimer.

The previous provisional double patenting rejection under 35 USC 101, set forth in paragraphs 6-7 of the office action mailed Aug. 18, 1999 is maintained. Said rejection is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Conclusion

Claims 15, 16, 18-24, 26-33 stand rejected.

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3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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CDM

Jan. 30, 2000


DWAYNE C. JONES
PRIMARY EXAMINER, 1614